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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MICHAEL W. JOHNSON, JOHN S. MINAMI, RYO KOYAMA,
and LANDON GENTRY

_____

Appeal 2009-011709
Application 10/049,972
Technology Center 2400

_____

Before JEAN R. HOMERE, JOHN A. JEFFERY, and THU A. DANG,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-59. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Appellants' invention connects Internet-ready devices and appliances to the Internet without a computer. *See generally* Abstract. Claim 1 is illustrative with key disputed limitations emphasized:

1. An apparatus for a user to connect an Internet-ready device to the Internet by an Internet connection independent means, comprising:
at least two connection ports, wherein the first port connects to an Internet conduit, and the second port connects to said Internet-ready device capable of communicating utilizing Internet-related protocols;
a user interface, allowing a user to initiate passing information between said Internet-ready device and said Internet, *and having associated indicators to indicate to said user that said passing of information that was initiated by said user is complete*;
a protocol handler block for receiving and handling messages from said user interface and from said Internet-ready device, and for sending on said handled messages to a network stack block;
said network stack block for handling an associated subset of said handled messages, and sending on to a physical connection block; and
said physical connection block for connecting to said Internet.

The Examiner relies on the following as evidence of unpatentability:

Reavey	US 5,847,698	Dec. 8, 1998
Sharpe	US 6,012,961	Jan. 11, 2000
Vaziri	US 6,377,570 B1	Apr. 23, 2002 (filed Mar 9, 1998)
Himmel	US 6,480,852 B1	Nov. 12, 2002 (filed Dec. 11, 1998)

C. Dianne Martin & Joseph M. Readgle, Jr., *An Alternative to Government Regulation Censorship: Content Advisory Systems for the Internet,*

Recreational Software Advisory Council, 1-11 (1997), *available at*
http://penta2.ufrgs.br/gereseg/censura/rsac/dianne1.htm ("Martin").

THE REJECTIONS

1. The Examiner rejected claim 57 under 35 U.S.C. § 112, ¶ 1 as failing to comply with the enablement requirement. Ans. 4.[1]

2. The Examiner rejected claim 57 under 35 U.S.C. § 112, ¶ 2 as indefinite. Ans. 5.

3. The Examiner rejected claims 1-12, 18-38, and 44-57 under 35 U.S.C. § 102(e) as anticipated by Vaziri. Ans. 5-10.

4. The Examiner rejected claims 13-16 and 39-42 under 35 U.S.C. § 103(a) as unpatentable over Vaziri and Himmel. Ans. 10-12.

5. The Examiner rejected claims 17 and 43 under 35 U.S.C. § 103(a) as unpatentable over Vaziri, Himmel, and Martin. Ans. 12-14.

6. The Examiner rejected claim 58 under 35 U.S.C. § 103(a) as unpatentable over Vaziri and Sharpe. Ans. 14-15.

7. The Examiner rejected claim 59 under 35 U.S.C. § 103(a) as unpatentable over Vaziri and Reavey. Ans. 15-16.

THE ENABLEMENT AND INDEFINITENESS REJECTIONS

The Examiner finds that closing the Internet to permit an Internet connection in claim 57 is not enabled by Appellants' disclosure and renders the claim indefinite since it is unclear how to open a closed Internet connection. Ans. 4-5, 16-17.

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[1] Throughout this opinion, we refer to (1) the Appeal Brief filed August 31, 2006; (2) the Examiner's Answer mailed May 9, 2007; and (3) the Reply Brief filed July 3, 2007.

Appellants argue that the recited closure is not complete as the Examiner seems to suggest, but rather partial by permitting an Internet connection only to a website specified by the Internet-ready device—an explicit condition recited in the claim. App. Br. 10-11; Reply Br. 2-4. The issues before us, then, are as follows:

ISSUES

Has the Examiner erred in rejecting claim 57 by finding that closing the Internet permitting an Internet connection only to a website specified by the Internet-ready device:

(1) is not enabled by Appellants' disclosure under § 112 ¶ 1, and

(2) renders the claim indefinite under § 112 ¶ 2?

FINDINGS OF FACT (FF)

1. Claim 57 depends from claim 12 which recites "[t]he apparatus of Claim 1, wherein said connection between said Internet-ready device and said Internet is closed in that said user never intervenes to provide additional information."

PRINCIPLES OF LAW

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988) (citation omitted).

Claims must "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2. The test for definiteness under § 112 is "whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

ANALYSIS

Based on the record before us, we find error in the Examiner's enablement and indefiniteness rejections. As Appellants indicate (Reply Br. 2-4), claim 57 depends from claim 12 which explicitly defines what is meant to "close" an Internet connection in the context of the claimed invention. That is, the connection is closed in that the user never intervenes to provide additional information. FF 1. Dependent claim 57 further specifies that this closure permits an Internet connection *only to a website specified by the Internet-ready device*—a key qualifier that clarifies the limited nature of this closure. Although dependent claim 57 somewhat inartfully refers to "said closure of said Internet" with respect to claim 12's closure of the Internet *connection*, the claim is nonetheless sufficiently clear in this regard when construed in context and in light of the Specification.

We therefore find that (1) the subject matter of claim 57 is enabled by Appellants' disclosure § 112, ¶ 1, and (2) the claim is definite under § 112, ¶ 2. Accordingly, we are persuaded that the Examiner erred in rejecting claim 57 on these grounds.

THE ANTICIPATION REJECTION

Regarding independent claim 1, the Examiner finds that Vaziri's Internet Switch Box (ISB) connects an "Internet-ready device" (a computer) to the Internet by connection-independent means, where the ISB is said to have a user interface with the recited indicators, and a "protocol handler block" which the Examiner equates with the ISB microprocessor's protocol-based functionality. Ans. 5-6, 17-20.

Appellants argue that Vaziri does not disclose a protocol handler block for receiving and handling messages from (1) the user interface, and (2) the Internet-ready device, let alone send those handled messages to a "network stack block" as claimed. App. Br. 11-14; Reply Br. 4-11. Appellants add that Vaziri does not disclose a user interface with indicators to indicate completing user-initiated information passage between the Internet-ready device and the Internet as claimed. Appellants also argue that Vaziri fails to disclose embedding the apparatus into an Internet-ready device, where the apparatus has a user interface block to connect to the device as recited in claim 52. The issues before us, then, are as follows:

ISSUES

Under § 102, has the Examiner erred by finding that Vaziri discloses:

(1) a user interface with indicators to indicate completing user-initiated information passage between the Internet-ready device and the Internet as recited in claim 1?

(2) a protocol handler block for (a) receiving and handling messages from (i) the user interface, and (ii) the Internet-ready device, and (b) sending those handled messages to a network stack block as recited in claim 1?

(2) embedding the apparatus into an Internet-ready device, where the apparatus has a user interface block to connect to the device as recited in claim 52?

ADDITIONAL FINDINGS OF FACT

2. Vaziri's system places telephone calls over a specific secondary network (e.g., the Internet) via a standard telephone connection using the Public Switched Telephone Network (PSTN). To this end, an ISB 100 connects between a telephone set and a PSTN line which is used for (1) PSTN telephone conversations, and (2) connecting to an Internet Service Provider (ISP). After establishing a telephone PSTN connection, users can switch to an Internet telephone conversation by signalling their respective ISBs which, in turn, disconnect the PSTN call and connect to their ISPs to continue the call via the Internet. Vaziri, Abstract; col. 1, ll. 13-17; col. 5, l. 55 – col. 6, l. 12; col. 7, ll. 11-40; Fig. 1.

3. The ISB includes a microprocessor 201 that executes the software architecture in Figure 2A. The ISB includes maintenance component 2A07 that interacts with various drivers including (1) Transfer Control Protocol/User Datagram Protocol (TCP/UDP) driver 2A13; (2) Internet Protocol (IP) driver 2A15; and (3) Point-to-Point Protocol (PPP) driver 2A17. These drivers serve as modifiable, embedded networking software for packetizing data and allowing communications with the Internet, thus corresponding to a Winsock driver on a conventional PC running Windows 95, 98, or NT. Vaziri, col. 9, ll. 13-15; col. 10, ll. 1-16; Figs. 2-2A.

4. The ISB's front panel 302 includes (1) menu button 301 enabling users to enter a menu-driven programming mode, and (2) Internet button 303

that switches calls to the Internet. Status indicator LEDs 304, 306, 307, and 311 are also on the front panel, three of which indicate (1) whether power is on or off; (2) the status of an Internet call attempt; and (3) whether any messages are waiting. Vaziri, col. 6, ll. 54-59; col. 7, ll. 19-22; col. 11, ll. 11-16; Fig. 3.

5. The back of the ISB includes (1) telephone jacks 404, 406 to connect to a telephone and telephone line, respectively, and (2) optional port 408 (e.g., serial, parallel, Universal Serial Bus (USB)) to connect to another device, such as a PC. Vaziri, col. 12, ll. 1-6; Fig. 4.

6. The ISB can poll the ISP periodically (1) whenever a call is completed over IP, or (2) to check for messages and indicate via an LED when messages are waiting. Vaziri, col. 1, l. 58; col. 18, ll. 5-17; Figs. 7D-E.

7. ISBs can be used in help desk applications to enable customer service agents to assist customers by remotely programming their ISBs 100C via the agent's computer 908 which is coupled to a specially-equipped ISB 100HD. Vaziri, col. 22, l. 21 – col. 23, l. 21; Figs. 9, 12.

8. Vaziri's ISB is connected to or integrated within a telephone. Vaziri, col. 3, ll. 21-23, 64-66.

PRINCIPLES OF LAW

In general, a preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. . . . Conversely, "a preamble is not limiting where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention."

Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed. Cir. 2002) (citation omitted). *See also Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997) (noting that when the claim preamble recites structural limitations of the claimed invention, the USPTO must give effect to that usage).

ANALYSIS

Claims 1-12, 18-38, 44-51, and 55-57

Based on the record before us, we find error in the Examiner's anticipation rejection of independent claim 1 which recites, in pertinent part, a user interface with indicators to indicate *completing* user-initiated information passage between an Internet-ready device and the Internet. Although the functionality of the front panel of Vaziri's ISB is a user interface, and this interface has LEDs that indicate, among other things, whether any messages are waiting (FF 4), we fail to see how these indicators *necessarily* indicate *completing* user-initiated information passage between an Internet-ready device and the Internet. We find unavailing the Examiner's reliance on the ISB's indicating "waiting" messages in this regard (Ans. 20), for while a "waiting" message implies that passing information associated with that message is complete (at least with respect to its delivery), we cannot say that such a message was *necessarily* initiated by the user via the recited apparatus' user interface as claimed. Nor can we say that this completed "passing of information" associated with the "waiting message" would *necessarily* be between the Internet-ready device and the Internet as claimed.

We reach this conclusion despite the ISB's periodically polling the ISP to check for messages and determine completed IP calls. FF 6. Here again, we cannot say that the ISB's front-panel indicators *necessarily* indicate *completing* user-initiated information passage between an Internet-ready device and the Internet as claimed. The Examiner's inherency position in this regard is therefore problematic, and we reverse the anticipation rejection for that reason alone.

We also find the Examiner's position regarding the recited "protocol handler block" problematic. Claim 1 recites a protocol handler block for (1) receiving and handling messages from (a) the user interface, *and* (b) the Internet-ready device, *and* (2) sending those *handled* messages to a "network stack block." Although Vaziri's ISB microprocessor uses drivers with various Internet-based protocols as the Examiner indicates (Ans. 17-18; FF 3), we cannot say that this functionality *necessarily* receives and handles messages from (1) the user interface (which the Examiner apparently equates to the functionality of the ISB's front-panel enabling user input as noted above), *and* (b) the "Internet-ready device" which the Examiner equates with the help desk customer service agent's computer (Ans. 18). And even assuming, without deciding, that the ISB microprocessor constitutes a "protocol handler block," we cannot say that it *necessarily* "sends on" (i.e., relays) these *handled* messages to a "network stack block" as claimed.

That the Examiner refers to a different reference ("Stevens") that was not cited in the rejection (or in the Examiner's Answer for that matter)[2] for

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[2] Although the Examiner indicates that the uncited Stevens reference is "attached in the Appendix" (Ans. 18, 20), it is not present in the latest

the notion that (1) a "transport layer" of a "TCP/IP protocol suite" anticipates the recited "protocol handler block" (Ans. 18), and (2) an associated "network layer" corresponds to the recited "network stack block" only further undermines the basis for the Examiner's anticipation rejection. Although the Examiner's reliance on this additional reference is not necessarily improper as Appellants contend (Reply Br. 7, 11),[3] it is nonetheless puzzling on this record, for it is unclear whether this extra reference is cited to show an inherent characteristic of Vaziri's ISB.

Nonetheless, even if this is the Examiner's intention, to say that a transport layer (even assuming that Vaziri's ISB has such a layer) *necessarily* receives and handles messages from (1) the user interface (which the Examiner apparently equates to the functionality of the ISB's front-panel enabling user input as noted above), *and* (b) the "Internet-ready device" (which the Examiner equates with the help desk customer service agent's computer (Ans. 18)) simply strains reasonable limits on this record. Nor can we say that these particular handled messages are *necessarily* sent on to a "network stack block," even assuming that such a block could somehow be a network transport layer as the Examiner seems to suggest (Ans. 19-20). We therefore find the Examiner's anticipation rejection problematic for these additional reasons.

Examiner's Answer before us on appeal. *Accord* Ans. 3 (omitting Stevens from the Answer's "Evidence Relied Upon" section).
[3] *See* MPEP 2131.01 (noting that citing multiple references in anticipation rejections is proper when the extra references (1) prove the primary reference contains an enabled disclosure; (2) explain the meaning of a term used in the primary reference; or (3) show that a characteristic not disclosed in the reference is inherent).

We are therefore persuaded that the Examiner erred in rejecting (1) independent claim 1; (3) independent claim 27 which recites commensurate limitations; and (3) dependent claims 2-12, 18-38, 44-51, and 55-57 for similar reasons. Since our decision is dispositive regarding our reversing the rejection of these claims, we need not address Appellants' other arguments pertaining to claims 11 and 37 (App. Br. 17-18; Reply Br. 18).

Claims 52-54

We will, however, sustain the Examiner's anticipation rejection of independent claim 52. First, we find that the limitation reciting embedding the apparatus into the Internet-ready device in the preamble recites essential structure that cannot be ignored. *See Catalina Marketing*, 289 F.3d at 808; *see also Rowe*, 112 F.3d at 478. Although we agree with Appellants' position in this regard (Reply Br. 16), Appellants' quote from *In re Stencel*, 828 F.2d 751 (Fed. Cir. 1987) is apparently misplaced, for the case does not contain that particular language.[4] Rather, the case notes that whether statements of intended purpose in a preamble limit the claim is a factual inquiry that must be determined on a case-by-case basis. *Id.* at 754-55.[5]

Nevertheless, we find no error in the Examiner's position that this limitation is fully met by Vaziri's integrating the ISB into the telephone.

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[4] *See* Reply Br. 16 ("[A]ttention is drawn to *In re Stencel . . .* which states that [i]n claims directed to articles and apparatus, any phraseology in the preamble that limits the structure of that article or apparatus must be given weight.'").

[5] See *Stencel*, 828 F.2d at 754 ("Whether a preamble of intended purpose constitutes a limitation to the claims is, as has long been established, a matter to be determined on the facts of each case in view of the claimed invention as a whole." (citations omitted)).

Ans. 21; FF 8. Unlike claim 1 where the Examiner mapped the "Internet-ready device" to the help desk computer, the Examiner apparently maps the *telephone* to the "Internet-ready device" in connection with claim 52. *See* Ans. 21. This mapping is reasonable, for the telephone is certainly an "Internet-ready device": indeed, being able to conduct telephone conversations over the internet in lieu of conventional phone connections is the very point of Vaziri's invention. *See* FF 2. Therefore, we agree with the Examiner that Vaziri teaches embedding the ISB apparatus into Internet-ready phone devices. And these embedded apparatus would include a "user interface block" to connect to the Internet-ready phone device as claimed, particularly in view of the user-interface and connection functionality provided by the ISB itself. *See* FF 4-6. Appellants' arguments in this regard (Reply Br. 17) are unavailing and, in any event, not commensurate with the scope of the claim.

We are therefore not persuaded that the Examiner erred in rejecting representative claim 52, and claims 53 and 54 not separately argued with particularity.

THE OBVIOUSNESS REJECTIONS

Since the Examiner has not shown that the cited prior art cures the deficiencies noted above regarding independent claims 1 and 27, we do not sustain the obviousness rejections of claims 13-17, 39-43, 58, and 59 (Ans. 10-16) for similar reasons.

CONCLUSION

The Examiner erred in rejecting (1) claim 57 under § 112, first and second paragraphs; (2) claims 1-12, 18-38, and 44-51, and 55-57 under § 102; and (3) claims 13-17, 39-43, 58, and 59 under § 103. The Examiner, however, did not err in rejecting claims 52-54 under § 102.

ORDER

The Examiner's decision rejecting claims 1-59 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED-IN-PART</u>

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